

U.S. Patent Application Serial No. 09/787,119
Amendment filed May 30, 2007
Reply to OA dated December 7, 2006

REMARKS:

Claims 1-19 are currently pending. Claims 1-5 and 12-16 are currently being considered, of which claim 12 has been amended herein. Claims 6-11 and 17-19 have been withdrawn from consideration.

The Examiner has rejected claims 1-5 and 12-16 under 35 USC 103(a) as obvious over USP 4,132,350 (Kubota) in view of USP 4,899,037 (Marechal).

Applicants respectfully traverse this rejection, for the following reasons.

The subject application relates to a transferable magnetic recording medium for manufacturing, via a transferring step, a magnetic card including a "printed pattern" having a great design formed on a magnetic recording layer, and at the same time, including superior recording reproduction properties in which variations in reproduced output do not occur.

In the transferable magnetic recording medium disclosed by the subject application, a printed layer is provided on a backing film, and subsequently, a magnetic recording layer is provided thereon. For this reason, in order to produce the magnetic recording layer having a uniform thickness and a smooth application surface, in which variations in reproduced output do not occur, it is necessary to make the thickness of the printed layer on which the magnetic recording layer will be

provided, uniform in both a pattern printed region and a filling layer region outside the aforementioned pattern printed region, and at the same time, it is necessary to provide the overall surface of the printed layer as a flat and smooth surface without differences in level.

As described above, one object of the principles disclosed in the subject application is to achieve a balance between providing designs and reduction of variations in reproduced output, in a magnetic card formed by a transferable magnetic recording medium; and to provide the transferable magnetic recording medium for use in manufacturing the aforementioned magnetic card. However, **Kubota's** object is to provide designs on a magnetic card, and fails to recognize possible adverse effects on magnetic properties which can occur when a magnetic card is manufactured via a transferring step using a transferable magnetic recording medium. Therefore, the object of **Kubota** is greatly different from the above-discussed object of the principles disclosed in the subject application.

In order to achieve the above-discussed object of the principles disclosed in the subject application, it is important that the overall thickness is uniform in order for no differences in level in the boundary surface of the magnetic recording layer provided on the printed layer to occur, regardless of the types of designs formed in the printed layer. As described in page 8, lines 15 to 21 of the specification of the subject application, the surface unevenness does not disappear, even when multicolor printing is used and the printing ink or the like is placed so as to cover the entire surface

of the backing, for as long as no particular attention is paid to adjusting the printing thickness, there will usually be a difference in the printing thickness between the different printing inks. Therefore, in order to provide a uniform thickness, specified adjustments are necessary.

However, **Kubota** fails to describe that the thickness of the printing layer is adjusted as described above. The Examiner indicated the description of **Kubota** (col. 3, line 20 to col. 4, line 27) describes that in the printing layer, a pattern region and a non-pattern region are formed. However, **Kubota** fails to describe the adjustment of the thickness of the printing layer, and in addition, **Kubota** may also include an option in which a non-pattern region is not provided.

The description of **Kubota** indicated by the Examiner is based on Fig. 3 and Fig. 5, in accordance with the description in col. 3, line 8 (“Referring now to FIGS. 3 and 5”). As **Kubota** describes in col. 3, lines 8 to 10, that “the magnetic card 1 is fabricated by embedding a magnetic layer 3 at at least a part of a substrate 1_{ab}”, **Kubota** is based on a magnetic card manufactured by first, completely embedding the magnetic recording layer in substrate 1, so that the magnetic recording layer and the substrate have the identical plane surface; and subsequently, disposing a color layer, a pattern layer, and a protective layer, successively, on the entire surface of the substrate 1_{ab}. Therefore, in **Kubota**, there is no description of a magnetic card in which a magnetic recording layer and a printing layer are provided by a transferable magnetic recording medium, as described

by the principles disclosed in the subject application.

Therefore, in **Kubota**, there is not a problem concerning occurrences of variations of reproduced output caused by differences in level in the interface between the magnetic recording layer and the printing layer. In addition, in **Kubota**, the color layer and the pattern layer can be provided by successively layering by means of various methods on the flat magnetic recording layer which has been formed.

In addition, the Examiner indicated Fig. 14 of **Kubota**. Fig. 14 shows a transferable magnetic recording medium for manufacturing a magnetic card, but the non-pattern region is indicated by a blank in view of pattern layer 5 of Fig. 14. Therefore, Fig. 14 fails to clearly specify that the corresponding printing is carried out on the region formed from a filling layer disclosed by the subject application. In view of Fig. 14, it is appropriate that nothing is formed on the non-pattern region. Fig. 14 fails to describe, teach, or suggest the filling layer region set forth in claim 1 of the subject application.

Kubota fails to describe, teach, or suggest the filling layer region set forth in claim 1 of the subject application. However, even if one attempted to argue that **Kubota** did describe such a region, which it does not, **Kubota** still would fail to describe, teach, or suggest that an overall region

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of a pattern layer 5 is adjusted in order to have a uniform thickness.

The Examiner asserted that from Fig. 14, a region corresponding to the filling layer set forth in claim 1 is formed, and the overall printing layer is adjusted to have a uniform thickness.

However, the Examiner has not demonstrated where **Kubota** discloses that Figure 14 or any other drawing is drawn to scale. When an Examiner has not demonstrated that a reference indicates that drawings therein are drawn to scale, it is believed to be improper for the Examiner to rely on drawings within that reference to show particular sizes or angles.

Accordingly, it is submitted that it is improper for an Examiner to rely on Figure 14 of **Kubota** to show particular sizes, angles, or thicknesses before the Examiner demonstrates that **Kubota** discloses that Figure 14 is drawn to scale.

When a reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.").

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The Examiner has not demonstrated how **Marechal** could describe, teach, or suggest "a thickness of said printed layer is uniform."

In view of the above, the Examiner has not demonstrated how **Kubota** and **Marechal**, alone or in combination, could describe, teach, or suggest the following features set forth in claims 1 and 12: "a thickness of said printed layer is uniform," in combination with the other claimed features.


In view of the aforementioned amendments and accompanying remarks, all claims currently being considered are in condition for examination.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the Applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

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In the event that this paper is not timely filed, the Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,
ARMSTRONG, KRATZ, QUINTOS,
HANSON & BROOKS, LLP



Darren Crew
Attorney for Applicants
Reg. No. 37,806

DC/llf
Atty. Docket No. 010324
Suite 1000
1725 K Street, N.W.
Washington, D.C. 20006
(202) 659-2930



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Enclosure: Petition for Extension of Time